

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

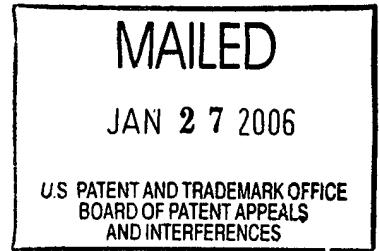
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PETER WORTHINGTON HAMILTON, KENNETH STEPHEN McGUIRE,
JOHN WILLIAM TOUSSANT, and JEFFREY MOSS VAUGHN

Appeal No. 2005-2458
Application No. 10/003,900

ON BRIEF



Before PAK, WARREN, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-20, all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The Examiner rejects all the pending claims, i.e., claims 1-20, under 35 U.S.C. § 103(a). As evidence of unpatentability, the Examiner relies upon U.S. Patent 5,965,235 issued to McGuire et al. (McGuire). McGuire describes prior work done within Procter & Gamble, the real party in interest in this appeal, by an inventive entity overlapping that of the application reviewed here.¹

Appellants state that the claims do not stand of fall together and groups claims 3-6 separately from claims 1, 2, and 7-20. To the extent that claims 3-6 are argued separately in accordance with 37 CFR § 1.192(c)(8), the rule in force at the time the Brief was filed, we consider them separately.² Otherwise, we select claim 1 to represent the issues on appeal.

We affirm and in so doing we adopt the findings of fact and conclusions of law presented by the Examiner in the Answer. We add the following primarily for emphasis.

OPINION

We first focus our attention on claim 1. Claim 1 is directed to a storage wrap material. Claim 1 reads as follows:

¹The U.S. Patent issued on October 12, 1999, more than one year before the filing date of the application being reviewed and, therefore, qualifies as "prior art" under 35 U.S.C. § 102(b).

²Note that effective September 13, 2004, 37 CFR § 1.192 has been replaced by 37 CFR § 41.37(c)(69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)).

1. A storage wrap material comprising

a sheet material having a thickness ranging from about 0.0001 inches (0.0025 mm) to 0.001 inches (0.025 mm), said sheet material having a first active side and a second side, the first active side comprising a plurality of three-dimensional non-adherent protrusions extending outwardly from surrounding depressions and

an adhesive composition coating on at least a portion of the depressions, wherein the adhesive composition coating has a thickness less than the height of the non-adherent protrusions and *from about 0.00001 (0.00025 mm) to about 0.0002 inches (0.0051 mm) in thickness.*

(formatting and emphasis added).

It is the adhesive coating thickness limitation emphasized above that is the focus of this appeal. There is no dispute that McGuire describes or suggests a storage wrap material having the sheet structure required by the claims and an adhesive composition coating contained within the depressions of the sheet. That the general conditions of the claimed storage wrap material is taught by McGuire is further evident from a comparison of Appellants' Figure 3 with McGuire's Figure 9.

It is the Examiner's position that even though McGuire does not expressly disclose the thickness range of the claimed adhesive composition coating, the guidance provided by the reference with regard to the general conditions of the storage wrap material indicates that the thicknesses were within the capabilities of those of ordinary skill in this art; the workable and/or optimal thickness range for the adhesive coating being the type of parameter readily determined through routine experimentation. The

Examiner cites *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (1955), in support of her position.

Appellants argue that McGuire “does not teach, disclose, or even remotely suggest the claim limitation as presented in Appellants’ claim.” (Brief, p. 6). This is because, according to Appellants, McGuire discloses an adhesive thickness range from about 0.0005 inch to about 0.002 inch, a range greater than the claimed range of about 0.00001 to about 0.0002 inch (Brief, p. 6). Thus, according to Appellants, “it is hard to understand how Appellants’ claimed range can even be considered a ‘discovery [of] the optimum or workable ranges.’” (Brief, p. 6).

Appellants’ argument overlooks the true nature of McGuire’s disclosure. The portion of McGuire disclosing specific thickness ranges is, in fact, merely providing a preferred thickness range for a specifically mentioned preferred composition made by H. B. Fuller Co. See column 17, lines 39-52 which states:

For fabrication of an adhesive-containing, three-dimensional, nesting-resistant sheet material, a *preferred* layer of substance 16 is preferably a latex pressure sensitive adhesive about 0.001 inch (0.025 mm) thick. Even more *preferably*, layer of substance 16 may be about 0.0005 inch (0.013 mm) thick layer to about 0.002 inch (0.051 mm) thick layer of hot melt adhesive, specification no. Fuller HL-2115X, made by H. B. Fuller Co. of Vadnais Heights, Minn. Any adhesive can be used which suits the needs of the material application. Adhesives may be refastenable, releasable, permanent, or otherwise. The size and spacing of protrusions is preferably selected to provide a continuous adhesive path surrounding protrusions so that air-tight seals may be made with a target surface.

As seen from the above reproduced portion of McGuire, McGuire does not limit the selection of adhesive to the hot melt of H.B. Fuller, but suggests that other adhesives may be selected. McGuire also indicates that protrusion design has an effect on sealing. These disclosures provide evidence that routine experimentation to find workable or optimal thickness ranges for a given adhesive and protrusion design was within the capabilities of one of ordinary skill in the art and would depend on the various selections made.

Appellants attempt to buttress their argument with the Wnuk Declaration (Brief, p. 7). But, again, the Declaration overlooks the critical fact that McGuire suggests more than simply providing a layer of about 0.0005 inch to about 0.002 inch thick adhesive for a particular adhesive. As we pointed out above, that is but one preferred thickness of a specific hot melt adhesive made by H. B. Fuller Co. The evidence provided in Wnuk Declaration does not overcome the suggestion of performing routine experimentation to determine workable and optimal thicknesses that is implicit in the disclosure of McGuire as discussed above.

In this situation, a *prima facie* case of obviousness is established and the burden shifts to Appellants to show that the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (1955). Appellants rely upon

no such evidence. We particularly note that Appellants very clearly indicate that the Wnuk Declaration is not relied upon to show unexpected results (Rely Brief, p. 3).

With regard to claims 3-6, Appellants argue that “[t]he prior art does not teach a storage wrap material having the limitations presented.” (Brief, p. 7). This argument does not address the specific findings of the Examiner with regard to the limitations of these claims (Answer, pp. 4-5) and, therefore, we do not find these arguments persuasive.

We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-20, which has not been sufficiently rebutted by Appellants.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-20 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

Catherine Timm
CATHERINE TIMM
Administrative Patent Judge

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